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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/878,177 06/18/97 IWAMOTO

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EXAMINER

MORGAN LEWIS & BOCKIUS  
1800 M STREET NW  
WASHINGTON DC 20036

CARLSON, K

ART UNIT

PAPER NUMBER

1653

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DATE MAILED:

05/19/99

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

## Office Action Summary

Application No.

Applicant(s)

Examiner

Group Art Unit

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3- MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

### Status

- ☒ Responsive to communication(s) filed on 1-8-99.
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

### Disposition of Claims

- ☒ Claim(s) 1-19 is/are pending in the application.
- Of the above claim(s) 1, 3-19 is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 2 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

### Application Papers

- ☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
- ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

\*Certified copies not received: \_\_\_\_\_.

### Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 3
- ☐ Notice of Reference(s) Cited, PTO-892
- ☒ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other \_\_\_\_\_

Office Action Summary

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Applicant's election without traverse of Group II, Claim 2 in Paper No. 5, filed January 8, 1999 is acknowledged. Claims 1 and 3-19 are withdrawn from further consideration because these claims are directed to non-elected inventions.

This application has been filed with informal drawings which are acceptable for examination purposes only. Formal drawings will be required when the application is allowed. The drawings are objected to because of the objections cited on the attached PTOL 948. Correction is required.

Applicants are reminded that once the drawings are changed to meet the separate numbering requirements in the PTO-948, Applicants are required to file an amendment (under 37 CFR 1.312 if the drawings are changed after allowance) to change the Brief Description of the Drawings and the rest of the specification accordingly.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 2 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 2 depends from non-elected Claim 1, rendering the Claim indefinite. For examination purposes, Claim 2 has been taken to incorporate

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the limitations of Claim 1.

The following is a quotation of the appropriate paragraphs of 35  
U.S.C. 102 that form the basis for the rejections under this section made in  
5 this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign  
country or in public use or on sale in this country, more than one year prior to the date of  
application for patent in the United States.

10 Claim 2 is rejected under 35 U.S.C. 102(b) as being anticipated by  
Dhordain et al. (1995; Mechanisms of Development 50:117-28). Dhordain et al.  
teaches the cDNA encoding c-erg. C-erg lacks amino acids 197-221 and 223-225  
in the amino acid sequence depicted in SEQ ID NO:2 (C-11 protein. Further,  
this c-erg is shown in the specification to have calcification inhibitory  
15 activity. Therefore, the cDNA encoding c-erg anticipates the gene encoding the  
protein of Claim 1.

20 No Claims are allowed.

Any inquiry concerning this communication or earlier communications from  
the Examiner should be directed to Karen Cochrane Carlson, Ph.D. whose  
telephone number is (703) 308-0034. The Examiner can normally be reached  
25 daily except alternate Fridays from 7:30 A.M. to 5:00 P.M.

If attempts to reach the Examiner by telephone are unsuccessful, the  
Examiner's supervisor, Mr. Bradley Sisson, can be reached at (703) 308-3978.  
The OFFICIAL fax phone number for Technology Center 1600 is (703) 308-4242.  
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Any inquiry of a general nature or relating to the status of this  
application or proceeding should be directed to the Technology Center 1600  
receptionist whose telephone number is (703) 308-0196.

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Karen Cochrane Carlson, Ph.D.  
Primary Examiner